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No. 1138

In the Supreme Court of the United States

OCTOBER TERM, 1969

THOMAS B. McGUIRE AND ANDREW POGAN,
PETITIONERS

v.

WILLIAM E. SCHUYLER, JR.,
COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

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OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. App. A) is reported at 416 F. 2d 1322.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on October 23, 1969. A timely petition for rehearing was denied on December 4,

1969. The petition for a writ of certiorari was filed on January 31, 1970. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTION PRESENTED

Whether the Court of Customs and Patent Appeals correctly sustained the Patent Office's denial of petitioners' patent application on the ground that the claimed invention was obvious in view of the prior art, within the meaning of 35 U.S.C. 103.

STATUTES INVOLVED

35 U.S.C. 102 provides, in pertinent part:

> A person shall be entitled to a patent unless—
>
> * * * *
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent * * *.

35 U.S.C. 103 provides, in pertinent part:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *

STATEMENT

On June 15, 1964, petitioners filed an application with the Patent Office for a patent to cover "an improved cutter for cutting tubes, pipes and other tubular members" (Tr. 5).[1] Petitioners' application (Tr. 5 *et seq.*), disclosed a tool for internally cutting primarily soft piping, such as copper tubing commonly used for water lines, at the exact desired spot and so as to leave the remaining pipe end beveled and substantially in its original cylindrical shape. It was claimed that this device would enable plumbers to cut tubing in close quarters where the commonly used external cutter could not be utilized, and would dispense with the need for reaming out and resizing the remaining tube end.

Investigation of the prior art revealed two earlier patents for internal pipe cutters—the Thomas and Vance patents, granted in 1867 and 1888 respectively (Pet. App. 31; Tr. 27-29)—which exhibited features essentially like those incorporated into petitioners' tool. The examiner denied petitioners' application on the ground that their tool was "obvious to one skilled in the art in accordance with 35 U.S.C. 103," because it consisted merely of "selecting various old features from the prior art and incorporating same into a single device, with each performing their old function" (Tr. 29). The examiner's decision was upheld by the Board of Appeals (Tr. 31), and the Court of Customs and Patent Appeals affirmed (Pet. App. 26-35).

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[1] "Tr." refers to the transcript of record filed in the United States Court of Customs and Patent Appeals, a copy of which is on file with the Clerk of the Court.

ARGUMENT

In *Graham* v. *John Deere Co.*, 383 U.S. 1, this Court admonished that the constitutional standard of patentability, as interpreted by the courts and as expressed in the Patent Act of 1952 (35 U.S.C. 101-103), continues to be strict and makes the grant of a patent "depend, in addition to novelty and utility, upon the 'non-obvious' nature of the 'subject matter sought to be patented' to a person having ordinary skill in the pertinent art" (383 U.S. at 14). It further noted that, in determining the obviousness or non-obviousness of the subject matter, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved" (383 U.S. at 17). Such a factual inquiry was conducted by the Patent Office upon the filing of petitioners' application, with the result that all those who have considered the claim have concluded that the prior art precludes issuance of a patent to petitioners. The correctness of this conclusion cannot be seriously disputed, and the case—involving as it does the application of settled principles in a particular factual setting—does not warrant further review.

1. There is no merit to petitioners' argument that the denial of their application "has been based on the pure *conjecture*" that their tool is obvious in light of the prior art (Pet. 12). A comparison of petitioners' tool with those embraced by the Thomas and Vance patents shows that the latter two, considered

together, contain all of the features present in the former, and that petitioners' tool does not represent a significant innovation or advancement. Issuance of a patent to petitioners would therefore violate the constitutional standard by removing "existent knowledge from the public domain," or by restricting "free access to materials already available" (*Graham* v. *John Deere Co.*, *supra*, 383 U.S. at 6.) Neither is petitioners' tool made patentable by the fact that, in the absence of familiarity with the Thomas and Vance patents, such a tool "has not been obvious to anyone else for the last 100 years", or that no evidence exists to show that it was ever produced by anyone before petitioners (Pet. 13, 15). With regard to the nonobviousness test, the inquiry is *not* whether petitioners' tool had ever before been produced, but whether, in light of the prior art, such a tool would be obvious to one having ordinary skill in the art. Moreover, this Court has declared that "[i]t is * * * irrelevant that no one apparently chose to avail himself of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search * * *" (383 U.S. at 36). In view of the prior patents, petitioners' application simply failed to meet the prescribed statutory standard, for "the subject matter sought to be patented * * * as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *" (35 U.S.C. 103; see Pet. App. 34-35).

2. There is likewise no merit in petitioners' contention that the Court of Customs and Patent Ap-

peals improperly placed on them the burden of establishing the non-obviousness of their cutting tool (Pet. 15-16). In the proceeding before that court, constituting an appeal by petitioners of an adverse administrative decision, the burden was on petitioners to show that the Board of Appeals erred in affirming the examiner's denial of their claimed patent. *Application of Steppan*, 394 F. 2d 1013, 1017 (C.C.P.A.). The court's function was to "hear and determine such appeal on the evidence produced before the Patent Office * * *" (35 U.S.C. 144). In addition, the decision of the Patent Office was to be accorded a presumption of validity. *Morgan* v. *Daniels*, 153 U.S. 120; *Gold* v. *Newton*, 254 Fed. 824, 827-828 (C.A. 2), certiorari denied, 249 U.S. 608; *Fletcher* v. *Watson*, 204 F. 2d 68, 69 (C.A.D.C.); *Abbott* v. *Coe*, 109 F. 2d 449, 451 (C.A.D.C.). On the basis of the record produced before the Patent Office, the Court of Customs and Patent Appeals was amply justified in affirming the administrative denial of a patent to petitioners.

CONCLUSION

For the reasons stated, the petition for a writ of certiorari should be denied.

Respectfully submitted.

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